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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,640	04/22/2004	Larry L. Russell	REED1001.12	5335

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EXAMINER

ALAUBAIDI, HAYTHIM J

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/828,640

Applicant(s)

RUSSELL, LARRY L.

Examiner

Haythim J. Alaubaidi

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>6-22-05</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is a final Office Action in response to the amendment of March 4, 2005.
2. Claims 1-9 are presented for examination, of which Claims 1 and 6 are independent Claims.
3. Claims 1-9 are rejected under 35 U.S.C. 103(a).

Regarding Notice of Non-Compliant

4. After hearing the Applicant's representative arguments (see Interview Summary June 27, 2005); the Examiner agreed that the Amendment of March 04, 2005 is in compliance with 37 CFR 1.121.

The Notice of Non-Compliant Amendment sent by the Examiner on May 26, 2005 is hereby withdrawn. The Examiner agreed to send an Office Action in response to the Applicant's Amendment filed on March 04, 2005.

Priority

5. Applicant claim for priority of US provisional Application No. 60/171,620 was accepted and therefor accorded the benefit of the earlier filing date of December 23, 1999.

Response to Arguments

6. Applicant's arguments filed in the amendment of March 04, 2005 have been fully considered but they are not persuasive.

a. Applicant argues on Page 3 and part of Page 4 of the amendment that the Examiner interpretation of "billboard" is not the same as what was meant by the Applicant. The Examiner however respectfully disagrees. In the computer technology art, a billboard could be interpreted as an electronic space for an advertisement from one or many sources. In addition, applicant argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., meaning of billboard) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Applicant provided two meanings for the term "billboard" in his arguments on Page 3 of the Amendment which none of them are in the specification of the current application. The Applicant also refers to Page 6 of the Specification of the current Application for the meaning of the term "billboard"; the Examiner was un-able to find any meaning for the term "billboard" other than indications (identifiers) referring to the billboard. The Examiner recognizes that the Application is trying to establish a certain type of billboards (physical outdoor

billboards) yet the Specification is not clear on that, and even if it was, the Claims does not specify what type of billboards are being used.

b. Applicant argues on Page 4, last paragraph of the amendment that the “directed search” indicated in the claims is different from what the Examiner cited. The Applicant also indicates that hi search results are always relevant, unlike what was taught by Davis. The Examiner however respectfully disagrees. The indication of the relevancy for the search result is not part of the claims, and even if it was, Davis search and returned results are also relevant to the term or keyword entered (please see Davis, Col 5, Lines 18-20).

c. Applicant argues on Page 5, first complete paragraph of the amendment that Bandera’s advertisement presented to the user is not “requested”, but generated base on the user’s location and that the current Application’s advertisement is requested by the user. The Examiner however was unable to locate in the claims a user requesting the advertisement.

d. Applicant argues on Page 5, second complete paragraph of the amendment that the “location” information is by the “input by the user”. The Examiner however was unable to locate in the claims a user inputting the location information.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9, are rejected under 35 U.S.C. 103(a) as being unpatentable over Darren J. Davis (U.S. Patent No. 6,269,361 and Davis hereinafter) in view of Daniel Bandera (U.S. Patent No. 6,332,127 and Bandera hereinafter).

Regarding Claims 1 and 6, Davis, discloses:

creating a database¹ containing one or more website identifiers input by an advertiser² associated (relevant) with the advertisement of the website address of the billboard³ (Figure No. 3, Element No. 282 and corresponding text; see also Figure No 5, Elements 330 and 352-356 and corresponding text; see also Figure No. 7 and corresponding text; see also Col 5, Lines 18-20);

¹ Please note that according to Figure 3, Element 282, the Examiner is interpreting the "Account Management Server" to be the database for storing the web site identifiers.

² Please note that the Examiner is interpreting the "website identifier" to be similar to the "search term" or "keyword" of Davis's patent (Figure 5, Element 352 which is advertising information according to Figure 5, Element 330). Also the "advertiser" to be similar to a "web site promoter" (see Col 5, Lines 18-19).

permitting a user to search the database by inputting at least one of the website identifiers (Col 6, Lines 3-5; see also Col 5, Lines 20-22 and Lines 27-30); and

providing to the user a search response including one or more web site addresses advertised on the billboard (Figure No. 7 and corresponding text; see also Col 17, Lines 53-65)⁴.

Davis reference discloses all of the claimed subject matter set forth above, except it does not explicitly indicate the step of wherein one or more web site identifiers is a location where the user may have seen the advertisement of the web site address on the billboard. However, Bandera discloses wherein one or more web site identifiers is a location where the user may have seen the advertisement of the web site address on the billboard (Col 5, Lines 16-25).

Given the intended broad application of Davis system, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Davis with the teachings of Bandera to indicate a user location or an advertising location where the user may have seen the advertising in order to enhance the efficacy of advertising (Col 2, Lines 47-48; see also Col 2, Lines 24-25; see

³ The "billboard" could be interpreted to be any website or web-page on the internet, such as the search engine web site showing on Figure 7 of Davis's patent.

also Figure No. 6 and corresponding text) and to better personalize the advertising to the individual users level instead of a general level advertising.

Regarding Claim 2, Davis discloses wherein the response further includes information related to a web site (web site description) associated with the web site address advertised on the billboard (Figure No. 7, Element No. 720 and 760j and corresponding text; see also Col 6, Lines 1-5, i.e. web site description).

Regarding Claims 3 and 9, Davis discloses a subject matter of interest (Figure No. 9, i.e. car, auto and automobile; see also Figure No. 5, Element No. 352-356)⁵ also Bandera discloses time of day when the user may have seen the advertisement (Col 2, Lines 47-49; see also Col 5, Lines 16-25).

Regarding Claim 4, Bandera discloses wherein the location is a name of the city (Figure No. 6, i.e. North Carolina and Virginia).

Regarding Claims 5 and 7, Davis discloses password protection database (Figure NO. 2, Element No. 110 and corresponding text).

⁴ Please note that Independent Claim 6 was grouped with Independent Claim 1, as they both contain the same limitations except for the categorizing feature which is being addressed below (when referring to Figure No. 7 and 9, i.e. ranking) as ranking the terms would be similar to categorizing the identifiers.

⁵ Please note that the search terms selected by the advertiser are search terms relating to the web site to better describe the web site and to increase the chances for having a better and more accurate search result list (Figure No. 7 and corresponding text).

Regarding Claim 8, Davis discloses storing non-identifier information (Figure No. 7, Element No. 750 a-f).

Other Prior Art Made of Record

9. Crosby et al. (U.S. Patent No. 6628928) discloses an Internet-based interactive radio system for use with broadcast radio stations;

b. Hunter (U.S. Patent No. 6430605) discloses a system permitting retail stores to place advertisements on roadside electronic billboard displays that tie into point of purchase displays at stores; and

c. Litwin (U.S. Patent No. 6374228) discloses a rebate advertising system in use with moving objects.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Points of Contact

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haythim J. Alaubaidi whose telephone number is (571) 272-4014. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any response to this office action should be mailed to:

The Commissioner of Patents and Trademarks, Washington, D.C. 20231 or telefax at our fax number (703) 872-9306.

Art Unit: 2161

Hand-delivered responses should be brought to the Customer Service Window of the
Randolph Building at 401 Dulany Street, Alexandria, VA 22314

Haythim J. Alaubaidi

Patent Examiner
Technology Center 2100
Art Unit 2161


FRANTZ COBY
PRIMARY EXAMINER